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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,665	11/17/2000	Michael William Urbanski	057234-0101	4398

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EXAMINER
CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
3622	

MAIL DATE	DELIVERY MODE
01/25/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/714,665	URBANSKI ET AL.	
	Examiner	Art Unit	
	Donald L. Champagne	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 October 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2,4,5,8,14,17,19,20,23,25,26,29,32,34,35 and 40-57* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2, 4, 5, 8, 14, 17, 19, 20, 23, 25, 26, 29, 32, 34, 35 and 40-57* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 November 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102 and 35 USC § 103

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 2, 4, 5, 8, 14, 17, 19, 20, 23, 25, 26, 29, 32, 34, 35, 40-43, 47-50 and 54 are rejected under 35 U.S.C. 102(e) as being anticipated by DeLorme et al. (US005948040A).

4. DeLorme et al. teaches (Independent claims 40 and 47 and 54) a computer implemented method, computer readable storage medium containing said method and a system of communicating information concerning a target location for which a user seeks information from a server to a user's computing/communication device communicatively connected to said server on a network, the method comprising the steps of:

determining a said target location (*the Palisade restaurant* among restaurants along a user-selected route in Seattle, Washington, col. 49 line 60 to col. 50 line 8) specified by said computing/communication device independently of a current physical location of said computing/communication unit and said server;

at said server retrieving from a database at least one of a plurality of categories of sponsored information (col. 28 lines 1-6 and 56-64, and col. 47 lines 45-56*)* provided by exclusive sponsors (whoever bears the cost of the "15 % discount" promotion in dialog box ***595***, Fig. 5D and col. 50 lines 23-31)[1] for said target location; and

delivering said sponsored information (the dialog box ***595***) to said computing/ communications device (a *PDA*, col. 14 line 66 to col. 15 line 8 and 72 line 62 to col. 73 line 5) over said network (the *Internet*, col. 8 lines 1-3).

5. DeLorme et al. teaches at the citations given above claims 2, 4, 5, 8, 14, 17, 19, 20, 23, 25, 26, 29, 32, 34 (where the user selections read on "characteristics of the user"), 35, 41, 42, 48 and 49.

6. DeLorme et al. teaches claims 43 and 50 (col. 22 lines 7-11) and claims 46 and 53 (col. 21 lines 40-48).

7. Claims 44, 45, 51 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeLorme et al. (US005948040A). DeLorme et al. does not teach (claims 44 and 51) delivering sponsored information for a specific period of time. Official notice is taken (MPEP § 2144.03) that advertising was commonly sold for a specific period of time at the time of the instant invention. Because the common is obvious, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of DeLorme et al. that sponsored information be delivered for a specific period of time. Claims 45 and 52 do not add effective limitations because the application does not provide a *clear definition* (MPEP § 2111.01) of "sub-division". Any division, down to that including only of one sponsor (e.g., *the Palisade restaurant*, para. 6 above) reads on claims 45 and 52.

8. Claims 55 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeLorme et al. (US006664922B1) in view of Feezell et al. (US006253189B1).

9. DeLorme et al. does not teach (claim 55) an auction for a specific time period. Feezell teaches an auction for a specific time period (Abstract). Because Feezell teaches that non-auction methods have many deficiencies (col. 1 line 18 to col. 2 line 39), it would have been

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[1] A "sponsor" is "a person that pays for a project or activity", Merriam-Webster's Collegiate® Dictionary, 10th ed.

obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Feezell to those of DeLorme et al.

10. Neither reference teaches (claim 56) that an existing sponsor is permitted to match the highest bid. Official notice is taken (MPEP § 2144.03) that it was common, at the time of the instant invention, for vendors to offer special terms to those customers with whom they have a relationship. Because the common is obvious, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Feezell and DeLorme et al. that an existing sponsor is permitted to match the highest bid.

11. Claim 57 is rejected under 35 U.S.C. 102(a) as being anticipated by "Foreclosure Search", a website published on 25 January 1999. Foreclosure Search teaches a computer implemented method of communicating residential real estate (*number of bedrooms and baths*) foreclosure information concerning a target location (*zip code*) for which a user seeks residential real estate foreclosure information from a server to a user's computing/ communication device communicatively connected to said server on a network, the method comprising the steps of:

determining a said geographical region (*zip code*) specified by said computing/ communication device independently of a current physical location of said computing/ communication unit and said server;

at said server retrieving from a database at least one of a plurality of categories of sponsored information, *the Foreclosure Search website itself*,[2] which is related to residential real estate foreclosure provided by exclusive sponsors participating in residential real estate foreclosure transactions for said geographical region; and

delivering said sponsored information related to residential real estate foreclosure to said computing/communications device over said network.

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[2] One of ordinary skill in the art would understand "sponsored information" to be a euphemism for advertising, which in turn in is any information that promotes. The website is sponsored information that promotes itself.

Response to Arguments

12. Applicant's arguments filed with an amendment on 29 October 2007 have been fully considered but they are not persuasive.

13. Applicant argues (p. 11-12),

> "The Office Action at p. 3 refers to the mention of the Palisade restaurant in the disclosure of DeLorme to attempt to show that sponsored information is provided by DeLorme. However, the TRIPS system disclosed in DeLorme does not provide exclusive sponsored information. DeLorme does not disclose, teach or suggest that the information displayed on the Palisade restaurant is sponsor provided, i.e. provided by the Palisades."

Item 595 in Fig 5D identifies a promotion for the Palisades Restaurant, which reads "discount: 15% off Monday-Thursday". This or any other promotion is "sponsor-provided" by definition (whoever bears the 15% cost being the sponsor). Since this promotion is exclusive to (unique to) the Palisades Restaurant, it is provided by an "exclusive sponsor".

Conclusion

14. The references made of record and not relied upon are considered pertinent to applicant's disclosure. Squires (St. Petersburg Times, 23 August 1998) suggests the *Foreclosure Search* website was launched in or before August 1998.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

16. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.

18. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

20. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

21. Applicant may have after final arguments considered and amendments entered by filing an RCE.

22. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov.

At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

17 February 2008

/Donald L. Champagne/
Primary Examiner, Art Unit 3622